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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER VELASQUEZ, VANESSA T				
ART UNIT		PAPER NUMBER		
1733				
NOTIFICATION DATE		DELIVERY MODE		
05/19/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/565,558

Applicant(s)

BOUZEKRI ET AL.

Examiner

Vanessa Velasquez

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 7, 8 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7, 8 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-840)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election by Original Presentation

Newly submitted claims 14 and 15 are directed to an invention that lacks unity with the invention originally claimed for the following reasons:

The inventions of "Group A" (claims 3-5, 7, 8, 13) and "Group B" (claims 14 and 15) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" are defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art" (Rule 13.2). The examiner has retroactively considered the question of unity of invention in view of the search performed. A review of U.S. Patent 6,358,338 issued to Guelton et al. demonstrates that the special technical feature, the steel sheet, does not define a contribution which each of the inventions, considered as a whole, makes over the prior art (p. 2 of the Office Action mailed 7/2/2008). It is further found that hot rolling temperatures and hold times are known in the art, as demonstrated by Kim et al. (WO 93/13233) or Hoffmann et al. (US 2003/0145911 A1) and Ferguson ("Design for Deformation Processes," Vol. 20, ASM Handbooks Online).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14 and 15 are withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Status of Claims

Claims 3-5, 7, 8, and 13 are presented for examination on the merits. Claims 14 and 15 are withdrawn from consideration.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 3, 5, 7, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guelton et al. (US 6,358,338 B1) in view of Kim et al. (WO 93/13233), and further in view of Ferguson ("Design for Deformation Processes," Vol. 20, ASM Handbooks Online). The claims remain rejected for the same reasons described in the Office action dated 12/22/2010.
3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guelton et al. in view of Kim et al. and further in view of Ferguson, as applied to claim 3 above,

and optionally further in view of Andersson et al. (US 4,648,440). The claim remains rejected for the same reasons described in the Office action dated 12/22/2010.

4. Claims 3, 5, 7, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guelton et al. (US 6,358,338 B1) in view of Hoffmann et al. (US 2003/0145911 A1, hereinafter Hoffmann '911) or Hofmann et al. (WO 02/101109 A1, hereinafter Hofmann '109) and further in view of Ferguson ("Design for Deformation Processes," Vol. 20, ASM Handbooks Online). The claims remain rejected for the same reasons described in the Office action dated 12/22/2010.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guelton et al. in view of Hoffmann '911 or Hofmann '109 and further in view of Ferguson, as applied to claim 3 above, and optionally further in view of Andersson et al. (US 4,648,440). The claim remains rejected for the same reasons described in the Office action dated 12/22/2010.

Response to Arguments

6. Applicant's arguments filed 3/17/2011 have been fully considered but they are not persuasive.

First, Applicant argues that the compositional makeup of the steels of Kim contain Al in an amount of 0.1-6.0%, which is higher than the claimed range of 0.05% or less; thus, Kim and Guelton would not have led a person of ordinary skill in the art to the

invention as claimed in claim 3. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP § 2145(IV). The primary reference to Guelton discloses a composition that overlaps the claimed invention and teaches that Al is optional up to 6%, which overlaps the claimed range. Secondary reference to Kim, which is referenced by Guelton (col. 1, lines 29-36), is relied upon to illustrate that the claimed hot rolling temperature ranges are conventional, well known in the art, and advantageous because said temperature ranges allow for uniform heating. Kim is not relied upon to teach the Al content of the claimed invention. It should be noted that the Al content of the steels of Kim are not related to the hot rolling temperatures in such a way so as to teach away from the incorporation of said temperature ranges into the hot rolling process of Guelton. Thus, Guelton in view of Kim, when taken as a whole, would not deter a person of ordinary skill in the art from consulting Kim to approximate a reasonable hot rolling temperature for steels within the same general high-carbon, high-manganese family.

Second, Applicant makes a similar argument with respect to Hoffmann '911, a secondary reference, as Hoffmann '911 teaches a steel composition containing >2.50-8.00% Si. In response, as noted supra, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. The primary reference to Guelton discloses a composition that overlaps the claimed

invention and teaches that Si is at most 2.5%, which overlaps the claimed range.

Secondary reference to Hoffmann '911 teaches >2.5-8.00% Si, which abuts the Si range of Guelton and overlaps the claimed Si range. Hoffmann '911 is not relied upon to teach the Si content of the claimed invention. Hoffmann '911 is relied upon to illustrate that the claimed hot rolling temperature ranges are known in the art and particularly advantageous because said temperature ranges allow for the full use of C and B, which in turn increase tensile strength and yield point values. It should be noted that the Si content of the steels of Hoffmann '911 are not related to the hot rolling temperatures in such a way so as to teach away from the incorporation of said temperature ranges to the hot rolling process of Guelton. Thus, Guelton in view of Hoffmann '911, when taken as a whole, would not deter a person of ordinary skill in the art from consulting Hoffmann '911 to approximate a reasonable hot rolling temperature for steels within the same general high-carbon, high-manganese family.

With respect to the Andersson reference not teaching the claimed method, it is noted that Andersson is relied upon to teach limitations of a rolling apparatus as claimed in claim 4 and not process parameters or limitations. As noted supra, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa Velasquez whose telephone number is 571-270-3587. The examiner can normally be reached Monday-Friday 9:00 AM-6:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached at 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanessa Velasquez/

Examiner, Art Unit 1733

/Scott Kastler/

Primary Examiner, Art Unit 1733